

Appln. No. 10/564,039
Amd. dated October 17, 2008
Reply to Office Action of May 7, 2008
and Advisory Action mailed July 22, 2008

REMARKS

Claims 7 and 8 currently appear in this application. The Office Action of May 7, the Advisory Action of July 22, 2008 and the Office communication regarding the pre-appeal brief review have been carefully studied. These claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed. Applicant respectfully requests favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

Amendments to the Claims

It is assumed that the amendment filed July 1, 2008, was not entered, as the Advisory Action of July 22, 2008, indicated that the July 1 amendment would be entered for purposes of appeal. The present amendment cancels claim 1 and presents claim 1 as amended as new claim 7. Claim 8 recites specific compounds covered by the general formula of claim 7, namely, Chemical Formulae 1-50 as found on pages 10-26 of the specification as filed.

Rejections under 35 U.S.C. 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. The Examiner states that

it is not clear what rings are formed when monovalent substituents such as halogen, hydroxyl, cyano, etc. are substituents and if they form rings.

This rejection is respectfully traversed. Claim 1 has been replaced by new claim 7. New claim 7 defines R² to R⁵ in General Formula 1 by adding a proviso so as to exclude monovalent substituents when two neighboring groups of R² to R⁵ couple to each other to form rings.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph. The Examiner alleges that the breadth of the amended claims is not supported by the specification. The Examiner alleges that the properties of compounds of formulae 2 and 3 are presented in the Table, but it is unclear whether one could obtain similar optical properties using compounds of formulae 37 and 45, which have substantially different structures.

This rejection is respectfully traversed. Claim 7, which replaces cancelled claim 1, includes the recitation for the claimed amine compound of its absorption maximum, molecular sorption coefficient, fluorescence maximum, decomposition point, and glass transition point. Moreover, claim 7 defines the amine compound with the process for producing the same. The specification discloses many examples of the amine compounds, as Chemical Formulae 1-50 and provides

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guidance for producing them at page 26, last line to page 29, line 12. Additionally, the specification explains in detail the process for producing the amine compounds at pages 45-49, Examples 1-4, as follows: The Examiner has given no reason to believe that the compounds claimed do not have the properties recited in the specification at page 9, lines 3-24.

Although the amine compounds of this invention, including those represented by Chemical Formulae 1 to 50, are slightly different in starting reaction conditions and yields dependently on their structures, they can be obtained by the methods in Examples 1 to 4 or in accordance therewith.

Many Federal Circuit decisions have confirmed that "*ipsis verbis*" disclosure is not required to satisfy the written description requirement. As the Federal Circuit stated in *Union Oil of California v. Atlantic Richfield Co.*, 208 F.3d 989, 987; 54 USPQ2d 1227m 1232 (Fed. Cir. 2000), "The written description requirement does not require the applicant 'to describe exactly the subject matter claims, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed'"; "the written description requirement does not require identical descriptions of claimed compounds, but it requires enough disclosure in the patent to show one of skill in this art that the inventor 'invented' what is claimed." In

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the present application, the compounds have been described by chemical formulae and properties. One skilled in the art can readily ascertain what is the invention covered by claim 7.

Art Rejections

Claim 1 is reelected under 35 U.S.C. 103(a) as being unpatentable over Bader et al., and Yoshio et al.

It is respectfully submitted that claim 7, which replaces claim 1, is not obvious under 35 U.S.C. 103(a) over Bader et al. and Yoshio et al. The Examiner's position is that because the component parts are known in Bader and Yoshio, and the only difference is the combination of the elements of adder and Yoshio into a single molecule. However, the Examiner has not demonstrated how or why one skilled in the art would combine the moieties of Bader and Yoshio to obtain the particular compounds claimed herein. The Examiner conceded that Bader does not teach chromenone-tripheynylamine combinations such as compound A claimed renew, and Yoshio only teaches chromenones B with substituents on the rings or charge transfer substances.

It is respectfully submitted that one cannot predict with any degree of certainty if combining previously disclosed moieties will result in a useful compound, as chemical compounds have wildly unpredictable properties. The Federal Circuit in *Eli Lilly & Co. v Zenith Goldline Pharmaceuticals*,

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Inc., 2001 WL 139704, 5 S.D. Ind, 2001, aff'd 471 F.3d 1369; 2006 U.S. App. LEXIS 31748; 81 U.S.P.Q.2D (BNA) 1324, December 26, 2006, Decided, Rehearing denied by, Rehearing, en banc, denied by Eli Lilly & Co. v. Zenith Goldline Pharm., Inc., 2007 U.S. App. LEXIS 8750 (Fed. Cir., Mar. 29, 2007) US Supreme Court certiorari denied by Dr. Reddy's Labs., Ltd. v. Eli Lilly & Co., 2007 U.S. LEXIS 9133 (U.S., Oct. 1, 2007) US Supreme Court certiorari denied by Teva Pharm. USA, Inc. v. Eli Lilly & Co., 2007 U.S. LEXIS 10992 (U.S., Oct. 1, 2007), quoted Treatise: "In deciding obviousness under 103(a), the focus is not on the ability of chemists to imagine a compound, nor on their ability to synthesize a molecule to order, but on whether the prior art provided apparent reason or motivation to take the steps that led to synthesis of the new compound."

In the present case, the Examiner has given no motivation for preparing compounds as claimed herein, but has only demonstrated that the prior art shows each moiety of the claimed compounds. There is nothing in either Bader or Yoshio that would lead one skilled in the art to predict that the compounds claimed herein would have the properties claimed herein.

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It is respectfully submitted that the above disclosures in the specification provide sufficient guidance for one skilled in the art for preparing the amine compounds as claimed.

In view of the above, it is respectfully submitted that the claims are now in condition for allowance, and favorable action thereon is earnestly solicited.

Respectfully submitted,

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